

Remarks:

Status of Claims

Claims 9, 15, 29, 35, and 48 have been amended; claims 36 and 45-47 have been canceled; and new claims 49-51 have been added, such that claims 9-35, 37-44, and 48-51 are currently pending.

Remarks

In the Office Action, the Examiner:

withdrew allowance of claims 9-48;

rejected claims 15, 24-28, 35, 38-39, and 45-48 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter regarded as the invention;

rejected claims 9-12, 16, and 23 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,253,514 (hereinafter referred to as "Imamura");

rejected claims 9, 16, 22, and 40 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,989,657 ("Lipper");

rejected claims 29, 31, 33-34, and 37 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,401,079 ("Rooney");

rejected claims 45-47 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,724,905 ("Kachler");

rejected claims 13-15 and 18-19 under 35 U.S.C. §103(a) as being unpatentable over Imamura in view of U.S. Patent No. 5,277,479 ("Koyama");

rejected claims 13-15 and 18-19 under 35 U.S.C. §103(a) as being unpatentable over Lipper in view of U.S. Patent No. 4,072,358 ("Ridha");

rejected claim 17 under 35 U.S.C. §103(a) as being unpatentable over Imamura;

rejected claim 17 under 35 U.S.C. §103(a) as being unpatentable over Lipper in view of Mason;

rejected claims 20-21 under 35 U.S.C. §103(a) as being unpatentable over  
Imamura in view of U.S. Patent No. 4,223,952 ("Weld");  
rejected claims 20-21 under 35 U.S.C. §103(a) as being unpatentable over  
Lipper in view of Weld;  
rejected claims 24-25 under U.S.C. §103(a) as being unpatentable over  
Imamura view of U.S. Patent No. 3,724,905 ("Kachler");  
rejected claims 24-25 under U.S.C. §103(a) as being unpatentable over  
Lipper in view of Kachler;  
rejected claims 30, 32, and 35 under U.S.C. §103(a) as being unpatentable  
over Rooney in view of U.S. Patent No. 4,514,013 ("Woelfel");  
rejected claims 38-39 under U.S.C. §103(a) as being unpatentable over  
Rooney in view of Kachler;  
indicated that claims 26-28 and 48 would be allowable if amended to  
overcome the rejections under 35 U.S.C. §112, second paragraph;  
and  
indicated that claim 36 would be allowable if rewritten in independent form.

*1. Regarding the rejections of previously allowed claims.*

The Applicant first notes that "full faith and credit should be given to the search and actions of a previous examiner unless there is a clear error in the previous action or knowledge of the prior art". MPEP §706.04. "A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action." Id. "Great care should be exercised in authorizing such a rejection." Id. A primary examiner is required to be "personally responsible" for any rejection of a previously allowed claim, and the rejection of previously allowed claims requires the signature of a primary examiner. MPEP §§1004,1005. Thus, the present Examiner is without authority to reject previously allowed claims 9-48 absent the approval and signature of a primary examiner. The only signature appearing in the Office Action is that of the Examiner, who is not a primary examiner; the stamp of S. Joseph Morano, supervisory patent examiner, is deemed insufficient to meet

the express requirement of a signature evidencing the required level of due consideration. The Applicant does not waive this requirement, but hereafter responds to certain of the Examiner's asserted rejections in the hopes of expediting prosecution in the unlikely event that a primary examiner agrees to sign the Office Action after properly considering the rejections. If an Office Action with the required signature is not forthcoming, then the Applicant considers the current rejections improper and its responses moot, though any amendments made to the claims - solely for the purposes of clarity and not to overcome prior art - will stand as though made *sua sponte* by the Applicant and not in response to an Office Action.

The Applicant also notes that the Examiner has asserted multiple rejections of a cumulative nature. More specifically, claims 9 and 16 are each rejected on the same 35 U.S.C. §102(b) grounds twice over a multiplicity of references, and claims 13-15, 18-19, 17, 20-21, 24-25 are each rejected on the same 35 U.S.C. §103(a) grounds twice over a multiplicity of references. "The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, multiplication of references." MPEP §707.07(g). More specifically:

In selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's *disclosure* to avoid the citation of an unnecessary number. The examiner is not called upon to cite *all* references that may be available, only the "best." (37 CFR 1.104C(c).) Multiplying references, any one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution and should therefore be avoided. MPEP §904.03 (emphasis in original).

Thus, while the Examiner's multiple cumulative rejections are not *per se* improper, the Applicant respectfully requests that, in the future, the Examiner consider the MPEP's guidance, particularly its guidance on avoiding adding unnecessarily to the burden and cost of prosecution.

*2. Regarding the rejections under 35 U.S.C. §112, second paragraph.*

With regard to the Examiner's rejections of claims 15, 24-28, 35, 38-39, and 45-48 under 35 U.S.C. §112, second paragraph, the Applicant responds as follows. The Applicant first notes that these particular rejections concern matters that are highly subjective and therefore inconsequential and inappropriate at this stage of prosecution. The Examiner has clearly begun prosecution anew without any regard for or deference to the previous Examiner's findings. The Applicant respectfully suggests that avoidance of these sorts of trivial rejections is the very reason a primary examiner's consideration and signature are necessary to reject claims previously allowed.

With regard specifically to the rejections of claims 15 and 35, the Applicant is aware of no generic terminology associated with Kevlar. The Applicant notes, however, that E. I. du Pont de Nemours and Company ("DuPont") describes Kevlar as a material comprising long, highly-oriented molecular chains produced from poly-paraphenylene terephthalamide and having strong interchain bonding. Thus, the term Kevlar has been replaced in the claims with a variation of DuPont's description in order to address the Examiner's concerns and overcome the rejections. This, of course, is not new matter because it merely replaces a term with the definition that one with ordinary skill in the art would automatically associate with that term.

With regard specifically to the rejection of claim 45, claim 45 has been canceled.

With regard specifically to the rejections of claims 24-26, 38-39, and 45-48, and the Examiner's concern over use of the term "plug", the Applicant responds as follows. The Examiner resorts to a common dictionary, but dictionaries are devoid of context and so do not, as a general matter, reflect the definitions of terms as those terms are used in particular arts. Furthermore, the term at issue is not simply "plug" but rather "mud plug", which is a term commonly used in the art by those with ordinary skill in the art. Thus, the Applicant asserts that the term "mud plug" is not used contrary to its ordinary meaning nor given an uncommon definition, and, furthermore, that one with ordinary skill in the art would be familiar with and understand the term and its usage in the present application. Thus, the Examiner's rejection is improper.

Furthermore, even if “plug” were the term at issue, its usage in the present application is not “repugnant” to the term’s dictionary definition. The Examiner asserted that “[w]here an applicant Acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term”. The Examiner, however, has mischaracterized the applicable test. The test is correctly stated as: “[w]hile an applicant may be his or her own lexicographer, a term in a claim may not be given a meaning *repugnant* to the usual meaning of that term”. MPEP §706.03(d) (emphasis added). The difference between an “uncommon definition” (as the Examiner asserts the test to be) and a “repugnant definition” (as the test truly is) is an important one. The Applicant notes that:

The examiner’s focus during examination of claims for compliance with the requirement for definitiveness of 35 U.S.C. §112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available...Examiners...should not reject claims or insist on their own preferences if other modes of expression selected by the applicants satisfy the statutory requirements. MPEP §2173.02.

The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification...it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies....No term may be given a meaning *repugnant* to the usual meaning of the term... MPEP 608.01(o) (emphasis added).

As the meaning of the term “plug” is clear from the specification and, in any event, not repugnant to its usual meaning, the statutory requirements are met and the Examiner’s rejection is improper.

Additionally, amending the claims to use the term “cover” rather than “plug”, as suggested by the Examiner, raises issues of inconsistent usage that could make the amended claims indefinite:

The use of a confusing variety of terms for the same thing should not be permitted...While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. MPEP 608.01(o)

Although the terms of a claim may appear to be definite, inconsistency with the specification disclosure...may make an otherwise definite claim take on an unreasonable degree of uncertainty. MPEP §2173.03.

Thus, the claim amendments suggested by the Examiner would arguably necessitate corresponding amendments to the specification. As the suggested amendments are not necessary and the rejections are improper, the Applicant respectfully declines to undertake this burdensome task.

*3. Regarding the rejections of independent claim 9 and dependent claim 23 under 35 U.S.C. §102.*

35 U.S.C. §102(b) states in relevant part that “[a] person shall be entitled to a patent unless the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States...” For rejections based on anticipation under 35 U.S.C. §102(b), there is no question of obviousness or modification of the reference, rather a single reference must teach each, every, and all aspects of the claimed invention either explicitly or impliedly, and any feature not directly taught must be inherently present. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987);

MPEP §§706.02 and 2131. "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, a prior art device can perform all of the functions of a claimed apparatus and yet not anticipate the claimed apparatus if the claimed apparatus and the prior art device are structurally distinguishable. *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999); MPEP §2114. Thus, a rejection under 35 U.S.C. §102(b) is overcome by persuasively distinguishing the subject matter and language of the claims from that which is disclosed by the cited reference. MPEP §706.02(b).

With regard to the rejection of claim 9 under 35 U.S.C. §102(b) as being anticipated by Imamura, the Applicant responds as follows. Imamura discloses a split or divided wheel rim 10a comprising substantially symmetrical inner and outer rim members 20a,40a, and an annular spacer 51a provided between inner flanges 23a,43a of the rim members 20a,40a. The rim members 20a,40a are each provided with a plurality of reinforcing ribs 24a,44a. Each rim member 20a,40a presents a bead 22a,42a including a hump or projection 27a,47a "which serves to prevent the associated tire from inadvertently displacing even when air leaks from between the opposite edges of the tires and the outer flange". Imamura, col. 2, lines 19-24.

The Examiner asserts, however, that Imamura discloses a first bead lock ring 47a having a first bead lock surface, and the wheel having a second bead lock surface 41a, such that the two bead lock surfaces act "to seal a tire bead therebetween"; and the circumferential raised rib 27a acting as a second bead lock ring with a third bead lock surface, and the wheel having a fourth bead lock surface 21a, such that the two bead lock surface act "to seal a second tire bead therebetween". This is a mischaracterization. Nowhere does Imamura disclose the humps or projections 27a,47a as acting in any manner or cooperating with any other component to seal a tire bead. To the contrary, the humps or projections 27a,47a are disclosed as merely preventing the tire from displacing when the seal is broken (i.e., air is leaking).

The Examiner is clearly aware of this distinction because he uses the humps or projections 27a,47a disclosed by Imamura to reject both the bead lock ring of claim 9 and the circumferential raised rib of claim 10. But whereas the bead lock ring of claim 9 facilitates sealing the tire between it and the bead lock surface, the circumferential raised

rib of claim 10 merely facilitates retaining the tire on the wheel. Imamura's humps or projections 27a,47a perform the latter function but not the former. Thus, the present invention as claimed in claim 9 functions differently and is structurally distinguishable from that which is disclosed by Imamura, and therefore the Examiner's rejection of claim 9 under 35 U.S.C. §102(b) is overcome. The rejection of dependent claim 23 is overcome for the same reason.

Claim 9 is nevertheless amended - not to avoid Imamura or other prior art, as claim 9 already clearly does this - but to further emphasize the adjustable nature of the bead lock ring so that its role in sealing the tire bead is more clearly appreciated.

With regard to the cumulative rejection of claim 9 under 35 U.S.C. §102(b) as being anticipated by Lipper, the Applicant responds as follows. Lipper discloses a two-piece modular automotive wheel 10 having a rear section 12 and a front section 14. The rear section 12 includes a center portion 12a and a rim portion 12b, and the front section 14 secures to the center portion 12a by a plurality of rivets 16.

In its discussion of the prior art, Lipper states:

Many prior art high performance wheels are three-piece types in which a pair of rim sections are secured...to a center section...One difficulty encountered in the manufacture of such wheels is that of achieving proper registration of the parts to ensure that they are all coaxial. In addition, the three-piece construction is more complicated, and therefore more expensive, than a typical two-piece wheel. Lipper, col. 1, lines 12-25.

Clearly, Lipper disparages three-piece wheels and identifies its own wheel as being a two-piece design. Thus, contrary to the Examiner's assertion, the center section 12a is not "interposed between and separably coupled with the inboard and outboard wheels halves (12 and 14, respectively)". Instead, the center section 12a is an integral and non-separable part of the rear section 12. Lipper describes this relationship as "a one piece first section having a center portion". By contrast, claim 9 of the present application requires that the center section be separably coupleable with the inboard and outboard wheel halves. Thus, the present invention as claimed in claim 9 functions differently and



is structurally distinguishable from that which is disclosed by Lipper, and therefore the Examiner's rejection of claim 9 under 35 U.S.C. §102(b) is overcome.

*4. Regarding the rejections of independent claim 29 and dependent claim 37 under 35 U.S.C. §102.*

With regard to the rejection of claim 29 under 35 U.S.C. §102(b) as being anticipated by Rooney, the Applicant responds as follows. Rooney discloses a plastic wheel assembly 10 comprising a rim 12 and a disk 14. The Applicant is unable to identify the "bead lock ring" asserted by the Examiner to be disclosed by Rooney, and, furthermore, the "bead lock surfaces" asserted by the Examiner as being disclosed by Rooney seem to be identical to the structures disclosed by Imamura. Thus, Rooney, like Imamura, does not disclose two surfaces cooperating to seal a tire bead therebetween, and this rejection is overcome. The rejection of claim 37 is overcome for the same reason. If the Examiner persists in this rejection in any subsequent properly considered and signed Office Action, the Applicant respectfully requests a clearer explanation of the structures referred to and relied upon by the Examiner.

Claim 29 is nevertheless amended - not to avoid Rooney or other prior art, as claim 29 already clearly does this - but to further emphasize the adjustable nature of the bead lock ring so that its role in sealing the tire bead is more clearly appreciated.

*5. Regarding the rejections of independent claim 40 and dependent claim 22 under 35 U.S.C. §102.*

With regard to the rejection of claim 40 under 35 U.S.C. §102(b) as being anticipated by Lipper, the Applicant responds as follows. The Examiner asserted that Lipper discloses:

The first bead lock surface 18a presents a first portion of an alignment mechanism, while the second bead lock surface 14a presents a second portion of the alignment mechanism. Both alignment mechanisms cooperate

to align a first bolthole 30 in the first bead lock surface 18a with a second bolthole 28 in the second bead lock surface 14a.

The Examiner, however, provides no identification of the structures disclosed by Lipper that supposedly operate as first and second portions of an alignment mechanism. As the Applicant is unable to identify such structures, the Examiner's assertion is without support and therefore there is nothing to rebut. Thus, this rejection is overcome. The rejection of dependent claim 22 is overcome for the same reason. If the Examiner persists in this rejection in any subsequent properly considered and signed Office Action, the Applicant respectfully requests a clearer explanation of the structures referred to and relied upon by the Examiner.

*6. Regarding claims 41-44.*

Though the Office Action summary states that claims 41-44 are rejected, the Applicant finds no grounds for or explanation of such rejections in the Examiner's discussion. Thus, there is nothing to rebut. The Examiner may wish to withdraw or expound on these rejections if they are maintained in any subsequent properly considered and signed Office Action.

*7. Regarding claims 26-28, 36, and 48.*

The Examiner indicated that claims 26-28 and 48 would be allowable if amended to overcome the rejections under 35 U.S.C. §112, second paragraph, and that claim 36 would be allowable if rewritten in independent form. As discussed, the Applicant does not agree with the Examiner's rejections of claims 26-28 and 48 over preferred terminology; therefore, rather than amend the original claims, the Applicant has added new claims 49 and 50 that correspond, respectively, to claims 26 and 48 having been amended as suggested by the Examiner (with claim 48 having been rewritten in independent form). Claims 26 and 48 are thereby preserved so that the rejections thereof under §112, second paragraph, may be appealed if necessary, and use of the broader term "cover" in the new

claims rather than the narrower term "mud plug" eliminates any issues of duplicate claiming (see MPEP §706.03(k)).

Also, in order to avoid upsetting the relationship of preceding and subsequent claims, claim 36 is canceled and reintroduced in independent form as new claim 51.

Thus, new claims 49-51 are in condition for allowance as indicated by the Examiner.

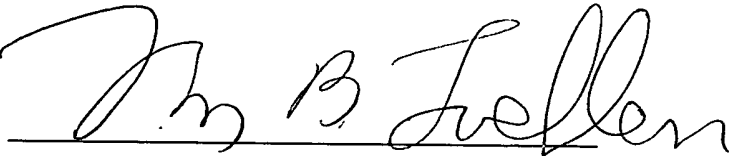
*8. Conclusion.*

In conclusion, the Applicant reiterates its position that the present Office Action, which rejects claims previously allowed, is considered improper and without effect for lack of a primary examiner's due consideration and signature, as are expressly required by the MPEP. The filing of the present amendments and remarks is not a waiver of this requirement.

In the event of any questions, the Examiner is urged to call the undersigned at 1-800-445-3460. Any additional fee which might be due in connection with this application should be applied against our Deposit Account No. 19-0522.

Respectfully Submitted,

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